

## **REMARKS**

Upon entry of this amendment, claims 14-27 are all the claims pending in the application. Claims 22-27 have been added as new claims. No new matter has been added.

### **I. Claim Rejections under 35 U.S.C. § 112, first paragraph**

Claims 14-21 have been rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement.

Regarding the above-noted rejection, in view of the Examiner's comments in item 1 on the Continuation Sheet of the Advisory Action dated June 3, 2010, Applicants note that in order to overcome the rejection, the claims have been amended herein by replacing the phrase "license information" with the phrase --license ticket-- throughout the claims. Support for this change can be found at least at page 1, lines 21-27 of the specification. In view of this modification to the claims, Applicants kindly request that the above-noted rejection be reconsidered and withdrawn.

### **II. Claim Rejections under 35 U.S.C. § 103(a)**

Claims 14-21 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Hori et al. (US 2002/0184154) in view of Ginter et al. (US 5,892,900).

#### **A. Claims 14-19**

Regarding claim 14 (which is an apparatus claim), Applicants note that in the Response to Amendment section of the final Office Action (see item 3 on pages 2-7), the Examiner has indicated that the functional language recited in claim 14 has not been given patentable weight

based on the language set forth in MPEP 2114 which indicates that claims directed to an apparatus must be distinguished in terms of structure rather than function.

Applicants respectfully disagree with the position being taken by the Examiner for the following reasons.

In particular, Applicants note that functional limitations of an apparatus claim require that the claimed apparatus include structure enabling it to perform the functional limitations. Thus, in order for a prior art reference to meet a functional limitation in an apparatus claim, the prior art structure must inherently be capable of performing that function.

For example, MPEP §2114, which was cited by the Examiner in the Office Action, provides evidence that a prior art structure must inherently be capable of performing the claimed function in order for the prior art structure to meet the claim limitation.

In particular, as specifically discussed in MPEP §2114, the Federal Circuit held in *In re Schreiber* (Applicants note that the Examiner has made reference to *In re Schreiber* on pages 3 and 4 of the final Office Action) that the absence of disclosure in a prior art reference relating to function did not defeat the Board's finding of anticipation of a claimed apparatus because the limitations at issue were found to be inherent in the prior art reference. In other words, because the prior art structure in *Schreiber* was inherently capable of performing the claimed functional limitations, the Federal Circuit found that the prior art structure anticipated the claim in question.

For example, a limitation to “a container for holding liquid in a leaktight manner” clearly includes functional language (i.e., “for holding liquid in a leaktight manner”), but would not be anticipated by a reference that discloses a colander, which is a container having a plurality of holes. In other words, while a colander is a type of container, because a colander has many

holes, it would not be inherently capable of holding liquid in a leaktight manner, and thus would not meet the claim limitation.

The Examiner appears to recognize this point (i.e., that the prior art structure must be inherently capable of performing the claimed functional language) by stating on page 14 of the final Office Action that “[i]f the prior art structure is capable of performing the intended use, then it meets the claim.”

In this regard, Applicants respectfully submit that the structure in the cited prior art does not perform the functions recited in claim 14, and is not inherently capable of performing the functions recited in claim 14. As such, Applicants respectfully submit that cited prior art does not render claim 14 unpatentable.

For example, Applicants note that claim 14, as amended, recites the feature of a digital signature management unit configured to (i) generate a hash value of the encrypted ticket before the encrypted license ticket is stored into the storage unit, and store the generated hash value into a built-in memory, and (ii) read the encrypted license ticket stored in the storage unit, generate a hash value of the read encrypted license ticket, and compare the hash value stored in the built-in memory with the generated hash value of the read encrypted license ticket, with a result of the comparison being used to verify validity of the read encrypted license ticket, the validity indicating that the read encrypted license ticket has not been tampered with.

Applicants respectfully submit that Hori and Ginter do not teach or suggest at least the above-noted feature recited in claim 14.

In particular, with respect to Hori, Applicants note that this reference discloses the use of a controller 1420 in a memory card 110, wherein the controller has the ability to generate a hash value, and to encrypt the generated hash value (see paragraph [0223]). In this regard,

however, Applicants note that the hash value of Hori is merely a hash value of status information (i.e., information in which a status flag is added to a reception log) (see paragraphs [0219] through [0222]), and therefore, is clearly not a hash value of an encrypted license ticket as recited in claim 14. It is noted that claim 14 indicates that the “license ticket” includes (i) an encrypted content key for decrypting encrypted digital content and (ii) content reproduction condition information indicating a range in which the digital content can be used.

In addition, as explained in Hori, a decryption process is performed on the encrypted hash value to obtain a signature data hash corresponding to the encrypted data, and then authenticity of the status information is checked based on the encrypted status and the signature data (see paragraph [0027]). Thus, while Hori discloses the ability to determine the authenticity of the status information based on the encrypted status information and the signature data, Applicants respectfully submit that this aspect of Hori does not correspond to the feature recited in claim 14 which indicates that the hash value stored in the built-in memory is compared with the generated hash value of the read encrypted license ticket.

Based on the foregoing, Applicants note that while Hori discloses the ability to generate a hash value of status information, and to determine the authenticity of the status information based on the encrypted status information and the signature data, that Hori does not disclose or suggest the above-noted feature recited in amended claim 14 of a digital signature management unit configured to (i) generate a hash value of the encrypted license ticket before the encrypted license ticket is stored into the storage unit, and store the generated hash value into a built-in memory, and (ii) read the encrypted license ticket stored in the storage unit, generate a hash value of the read encrypted license ticket, and compare the hash value stored in the built-in memory with the generated hash value of the read encrypted license ticket, with a result of the

comparison being used to verify validity of the read encrypted license ticket, the validity indicating that the read encrypted license ticket has not been tampered with.

Further, Applicants respectfully submit that Ginter fails to cure the above-noted deficiencies of Hori. Accordingly, Applicants respectfully submit that claim 14 is patentable over the cited prior art, an indication of which is kindly requested.

Regarding claims 15-19, Applicants note that these claims depend from claim 14 and are therefore considered patentable at least by virtue of their dependency.

### **B. Claims 20 and 21**

Regarding claim 20, Applicants note that this claim is a **method claim** which recites similar features as set forth above in claim 14 (which is an apparatus claim).

As explained above, the Examiner has not given patentable weight to the functional language recited in claim 14 because the Examiner believes that functional limitations in an apparatus claim should not be entitled to patentable weight (which is traversed by Applicants for the reasons set forth above).

With respect to the rejection of method claim 20, however, Applicants note that the Examiner has merely grouped the rejection of this claim together with the rejection of claim 14, without addressing the specific language set forth in the **steps** recited in claim 20.

In this regard, Applicants note that amended claim 20 recites the feature of a digital signature management step, being performed by the digital signature management unit, of (i) generating a hash value of the encrypted license ticket before the encrypted license ticket is stored into the storage unit, and storing the generated hash value into a built-in memory, (ii) reading the encrypted license ticket stored in the storage unit, generating a hash value of the read

encrypted license ticket, and comparing the hash value stored in the built-in memory with the generated hash value of the read encrypted license ticket, with a result of the comparison being used to verify validity of the read encrypted license ticket, the validity indicating that the read encrypted license ticket has not been tampered with.

Applicants respectfully submit that Hori and Ginter do not teach or suggest the above-noted feature recited in claim 20 for reasons at least similar to those described above with respect to claim 14. Accordingly, Applicants respectfully submit that claim 20 is patentable over the cited prior art, an indication of which is kindly requested.

Regarding claim 21, Applicants note that this claim also recites the feature of (i) generating a hash value of the encrypted license ticket before the encrypted license ticket is stored into the storage unit, and storing the generated hash value into a built-in memory, (ii) reading the encrypted license ticket stored in the storage unit, generating a hash value of the read encrypted license ticket, and comparing the hash value stored in the built-in memory with the generated hash value of the read encrypted license ticket, with a result of the comparison being used to verify validity of the read encrypted license ticket, the validity indicating that the read encrypted license ticket has not been tampered with.

Applicants respectfully submit that Hori and Ginter do not teach or suggest the above-noted feature recited in claim 21 for reasons at least similar to those described above with respect to claim 14. Accordingly, Applicants respectfully submit that claim 21 is patentable over the cited prior art, an indication of which is kindly requested.

### III. New Claims

Initially, it is noted that new claims 22-27 substantially correspond to claims 14-19. New claims 22-27, however, include several “means plus function” limitations (e.g., “digital signature management means”, “encrypting and decrypting means”, and “control means”).

Regarding the functional language recited in the above-noted “means plus function” limitations, Applicants note that MPEP § 2182 sets forth the following with respect to the “functional” portion of means-plus-function limitations:

Both before and after *Donaldson*, the application of a prior art reference to a means or step plus function limitation **requires that the prior art element perform the identical function specified in the claim** (emphasis added).

Thus, as is clear from the MPEP with reference to In re Donaldson Co., 16 F.3d 1189, 29 USPQ2d 1845 (Fed. Cir. 1994), it is necessary that the prior art structure perform the identical function recited in a means plus function limitation, and if the identical function is not performed in the prior art, then the prior art cannot be considered to meet the means plus function limitation.

Regarding claims 14-19, as noted above, the Examiner indicated in the final Office Action that the functional language has not been given patentable weight based on MPEP 2114 which indicates that claims directed to an apparatus must be distinguished in terms of structure rather than function. Applicants disagree with this position taken by the Examiner for the reasons set forth above, and further submit that such a position would clearly not be applicable to new claims 22-27 due to the means plus function limitations recited therein.

In other words, for a means plus function limitation, Applicants note that it is not sufficient that a prior art reference be inherently capable of performing the claimed function.

Instead, as noted above, it is necessary that the prior art structure perform the identical function recited in means plus function limitation, and if the identical function is not performed in the prior art, then the prior art cannot be considered to meet the means plus function limitation.

Regarding new claim 22, Applicants note that this claim recites the feature of a digital signature management means for (i) generating a hash value of the encrypted license ticket before the encrypted license ticket is stored into the storage unit, and storing the generated hash value into a built-in memory, and (ii) reading the encrypted license ticket stored in the storage unit, generating a hash value of the read encrypted license ticket, and comparing the hash value stored in the built-in memory with the generated hash value of the read encrypted license ticket, with a result of the comparison being used to verify validity of the read encrypted license ticket, the validity indicating that the read encrypted license ticket has not been tampered with.

For reasons at least similar to those as set forth above with respect to claim 14, Applicants respectfully submit that Hori and Ginter do not teach, suggest or otherwise render obvious the above-noted feature recited in claim 22. Accordingly, Applicants submit that claim 22 is patentable over the cited prior art, an indication of which is kindly requested. Claims 23-27 depend from claim 22 and are therefore considered patentable at least by virtue of their dependency.

#### **IV. Conclusion**

In view of the above, reconsideration and allowance of this application are now believed to be in order, and such actions are hereby solicited.



If any points remain in issue which the Examiner feels may best be resolved through a personal or telephone interview, the Examiner is kindly requested to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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/Kenneth W. Fields/

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